

REMARKS/ARGUMENTS

In response to the Notice of Non-Compliant Amendment mailed 03/05/2009, Applicant has corrected the Listing of the Claims to include the text of the withdrawn claims 1-7.

Claims 1-22 were previously pending in the application. Group II claims 8-22 were elected; claims 8-17 are amended; and claims 18-22 are canceled herein. The Applicant hereby requests further examination and reconsideration of the application in view of the foregoing amendments and these remarks.

In the event that the Examiner believes that this amendment does not place the application in condition for allowance, the Applicant requests a telephonic interview between the Examiner and the Applicant's attorney Ian M. Hughes to discuss this amendment. The Applicant requests that the Examiner call Mr. Hughes (610-933-8809) to arrange a convenient time for such an interview.

In paragraphs 1-3, the Examiner rejected claims 8-17 under 35 U.S.C. 112, second paragraph, as being indefinite. In response, Applicant has made numerous amendments throughout the claims to more point out and distinctly claim particular features of differing ones of "said one of said plurality of wireless phones" in claims 8-17. The Applicant therefore respectfully submits that the rejections of claims under Section 112, second paragraph, have been overcome.

In paragraphs 4 and 5, the Examiner rejected claims 8-10, 13-15, and 18-20 under 35 U.S.C. 102(e) as being anticipated by Rosener et al. (U.S. Pub. No. 2002/0028655, hereinafter "Rosener"). In order to be anticipated under 35 U.S.C. 102(b), all of the elements of Applicant's invention as claimed must be present in the allegedly anticipating reference. Applicant's amended claim 1 recites:

"registering one of said plurality of wireless phones, each registered wireless phone corresponding to an operator of said vehicle;
receiving a request for access to a wireless hands-free gateway from one of said plurality of wireless phones; and providing, by said wireless hands-free gateway, hands-free functionality to said one of said plurality of wireless phones **with a priority based on whether said one of said plurality of wireless phones is a registered wireless phone** [emphasis added]."

As recited in amended claim 8, a wireless phone is registered to an operator of the vehicle, and access to hands-free functionality is prioritized based on whether the operator's wireless phone is registered. Similar amendments are made to claim 13. Support for the amendments can be found throughout Applicant's specification and, in particular, at page 7, line 8, through page 8, line 30, and page 11, line 11, through page 12, line 28. Applicant submits that no new matter is added through these amendments.

Rosener describes a repeater system for wireless communications applications, and, by example, indicates that such repeater system might establish a piconet network in a vehicle and might be employed by an owner and passengers of a vehicle (see, e.g., Rosener, page 3, [0039]). However, the Examiner points to Rosener, page 11, [0138], for the proposition that Rosener teaches determining which of a plurality of participants in the piconet network is a current driver. Applicant respectfully disagrees with the Examiner's characterization of this passage in Rosener. Rosener, at page 11, paragraphs [0135]-[0138] describes granting access to the network by matching the number against allowed numbers in a list. Similarly, Rosener, at page 10, [0120]. Rosener, while speaking about the owner of the vehicle, describes only that the owner uses his phone and enables communication by a passenger's phone, and

even states that the repeater handles both calls simultaneously. Rosener simply does not describe or suggest actually registering a wireless phone so that it is identified with an owner operating the vehicle, and so prioritizing the operator's access to the hands-free functionality. Rosener does not identify or discuss the problem that a person in the act of operating a car should have prioritized access to the hands-free functionality for safety reasons, as discussed in Applicant's specification. Thus, Rosener does not describe or suggest that one or more wireless phones are registered to operators of the vehicle, and access to hands-free functionality is prioritized based on whether the operator's wireless phone is registered, as recited in Applicant's amended claim 8.

Since Rosener does not teach all of the elements of claim 8, Rosener does not meet the requirements of to be an anticipatory reference. Nor does the prior art suggest the elements of claim 1 that are missing from Rosener.

In paragraphs 7-9, the Examiner rejected claims 11, 16, and 21 under 35 U.S.C. 103(a) as being unpatentable over Rosener in view of Kinnunen (U.S. Pat. No. 6,687,517, hereinafter "Kinnunen") and claims 12, 17, and 22 under 35 U.S.C. 103(a) as being unpatentable over Rosener in view of Kuenzel (U.S. Pat. No. 4,399,330, hereinafter "Kuenzel"). For the following reasons, the Applicant submits that claims 8-17 are allowable over Rosener in view of Kinnunen and/or Kuenzel, either when taken alone or when taken in combination.

Kinnunen describes a hands-free piconet network established in a vehicle in which several classes of users are identified with respective priorities. See Kinnunen, col. 5, line 34, to col. 6, line 45. A first class of user is defined as a default user (the "father"), who initially sets up the network in the car and by default has a higher priority. Kinnunen then goes on to describe that the next programmed user (the "mother") is initialized. Other classes (the "daughter") are then programmed in. In each of these cases, the mobile phone communicates with the user to set up the connection. However, the system of Kinnunen doesn't actually identify that a highest priority is given to the person operating the vehicle. Kinnunen does not describe or suggest actually registering a wireless phone so that it is identified with an owner operating the vehicle, and so prioritizing the operator's access to the hands-free functionality. Kinnunen does not identify or discuss the problem that a person in the act of operating a car should have prioritized access to the hands-free functionality for safety reasons, as discussed in Applicant's specification.

Kuenzel describes a radio system for coupling mobile subscriber devices in a mass transit vehicle to allow for non-cash charges and in which the mobile users have stored location information. See Kuenzel, Summary of the invention. While Kuenzel does describe that the operator of the vehicle has a higher priority of access at Kuenzel, col. 5, lines 32-36, Kuenzel doesn't actually identify that a highest priority for hands-free operation is given to the operator, and does not, in fact, describe any reason for such priority. In addition, Kuenzel is describing access through codes on the user's identification card, and not through registration with the radio system. Kuenzel does not describe or suggest actually registering a wireless phone so that it is identified while operating the vehicle, and so prioritizing the operator's access to the hands-free functionality. Kuenzel does not identify or discuss the problem that a person in the act of operating a car should have prioritized access to the hands-free functionality for safety reasons, as discussed in Applicant's specification.

The recognition by the Applicant of a problem in the prior art cannot be used against the Applicant to support a conclusion of obviousness. See, e.g., *In re Dow Chemical Co.*, 837 F.2d 469, 472, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) ("[A] patent applicant's statement of the purpose of the work [in the specification] is not prior art."); *In re Fout*, 675 F.2d 297, 300 n.2, 213 USPQ 532, 535 n.2 (CCPA 1982) ("Absent a statutory bar under 35 U.S.C. 102(b), (c) or (d), an applicant's own invention cannot be 'prior art' to him.").

In addition, without a suggestion in the prior art for a necessary modification and/or combination, a rejection on the grounds of obviousness is an improper use of hindsight. If the prior art does not contain even a suggestion of the specific modifications that are needed to be made to the teachings of the prior art to yield the claimed invention, then a rejection on the grounds of obviousness based solely on the advantages provided by that claimed invention is an improper use of hindsight. See, e.g., In re Fritch, 972, F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'").

The Examiner uses Applicant's recognition of actually registering a wireless phone so that it is identified with a person operating the vehicle, and so prioritizing the operator's access to the hands-free functionality, to support a conclusion of obviousness. For example, in the Office Action at page 5, the examiner states "The *motivation for the modification* [of the reference] is to do so in order to provide priority for a particular person for using the hands-free functions." Such use of Applicant's recognition of the problem that a person in the act of operating a car should have prioritized access to the hands-free functionality for safety reasons, as discussed in Applicant's specification, is improper, and is also improper use of hindsight.

Therefore, Applicant submits that neither Rosener, Kinnunen, nor Kuenzel, when taken alone or in combination, describes or suggests that one of one or more wireless phones is registered to an operator of the vehicle, and access to hands-free functionality is prioritized based on whether the operator's wireless phone is registered, as recited in Applicant's amended claims 8 and 13. For similar reasons, Applicant submits that claims 9-12 that depend from claim 8 and claims 14-17 that depend from claim 13 are allowable over the cited references. The Applicant respectfully submits that the rejections of claims 8-17 under 35 U.S.C. 102(e) and 103(a) have been overcome.

In view of the above amendments and remarks, the Applicant believes that the now-pending claims are in condition for allowance. Therefore, the Applicant believes that the entire application is now in condition for allowance, and early and favorable action is respectfully solicited.

Respectfully submitted,



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